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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/409,457 09/30/99 FLAUTT

M 24649A

EXAMINER

IM52/0309

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ART UNIT

PAPER NUMBER

1713

DATE MAILED:

03/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/409,457

Applicant(s)

FLAUTT ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6 & 7.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to a water-resistant coating and an article comprising the coating, classified in class 428, subclass 364.
 - III. Claims 16-18, drawn to a method of forming a super-absorbent, water-resisting coating on an article, classified in class 427, subclass 222.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the coating as claimed can be formed by another and materially different process, for instance wherein the coating composition is applied to the substrate in the form of a slurry or wherein the coating is simply dried and no curing is required. Further, the coating can be formed wherein it is not applied to the entire surface of the article.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Inger Eckert on 3/01/01, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kono et al. (JP 04284236) or Shiono et al. (JP 06289262).

In the abstract, Kono et al. or Shiono et al. teach articles comprising coating layers on at least one surface, said coatings comprising a water-absorbent polymer and a binder.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

9. Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kroesbergen (WO 96/23024) or Manning et al. (USPN 5,071,681).

Each of Kroesbergen (page 1, lines 1-17, page 2, lines 16-37, page 3, lines 14-22, page 4, lines 12-29 and the Example on page 9) and Manning et al. (col. 1, lines 6-28 and col. 2, lines 5-61) teach fibrous polymeric articles comprising, on at least one surface, a coating comprising a water-soluble superabsorbent polymer and a binder.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 9-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Kono et al., Shiono et al., Kroesbergen or Manning et al., above.

12. Claims 1-5 and 8-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Gaa et al. (USPN 4,810,576) or Cossement et al. (USPN 5,236,982).

Each of Gaa et al. (col. 4, lines 50-55, col. 6, lines 5-60, col. 8, lines 12-14, col. 10, lines 5-7, and col. 11, lines 30-53) and Cossement et al. (col. 1, lines 44-51 and col. 5, lines 20-65,) teach fibers reinforcing material comprising coating/sizing compositions, said coating composition comprising an aqueous solution of a base neutralized polyacrylate, and polymeric/binder agents, along with any conventional compounds known to be useful in aqueous compositions for coating such fibrous substrate.

While Kono et al., Shiono et al., Kroesbergen, Manning et al., Gaa et al. or Cossement et al. do not expressly teach the disclosed properties of the claimed coating, it is reasonable that the coatings of Kono et al., Kroesbergen, Manning et al., Gaa et al. or Cossement et al. would poses the presently claimed properties since the compositions are essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition or article is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

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Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

13. Claim 1-15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arroyo et al. (USPN 4,913,517) or Geursen et al. (USPN 5,264,251) in combination with Barch et al. (USPN 4,466,151).

Each of Arroyo et al. (col. 3, line 1-15 and col. 4, lines 11-20) and Geursen et al. (col. 1, lines 7-10 and col. 3, lines 31-41) teach superabsorbent-coatings for fibrous substrate, such as aramids, comprising a water-soluble polymer and other optional component such a viscosity modifying polymers.

Arroyo et al. or Geursen et al. differ from the claimed invention in that the coatings are not explicitly disclosed as comprising binders. However, it is well known in the art to incorporate a binder into a coating composition for fibrous substrate, for the purpose of facilitating the formation of a film on the substrate upon the drying of the coating composition, such as taught by Barch et al. (See col. 6, lines 18-20).

In col. 5, lines 61-66 and col. 6, lines 10-59, Barch et al. teach a coating for fibrous substrate, said coating prepared from a composition comprising an film forming binder, such as a polyurethane.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to incorporate a binder into the fiber coatings of

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Arroyo et al. or Geursen et al. in order to obtain the advantages taught by Barch et al., motivated by a reasonable expectation of success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3599 for regular communications and 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.



KCE
March 6, 2001



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